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10/767,340	01/30/2004	Bryan R. Goring	T8467901US	5223

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EXAMINER	
DAO, THUY CHAN	

ART UNIT	PAPER NUMBER
2192	

NOTIFICATION DATE	DELIVERY MODE
08/09/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/767,340	GORING ET AL.	
	Examiner	Art Unit	
	Thuy Dao	2192	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 June 2011*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *43-70* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *43-70* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 January 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on June 6, 2011 has been entered.

2. Claims 43-70 have been examined.

Response to Arguments

3. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action.

Claim Rejections – 35 USC §101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 70 is rejected because the claimed invention is directed to non-statutory subject matter "A computer program product", which may comprise only software components.

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the

computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions. See MPEP 2106.

Under the principles of compact prosecution, claims 70 has been examined as the Examiner anticipates the claims will be amended to obviate these 35 USC § 101 issues. For example,

- -A computer program product <u>embedded in a non-transitory computer-readable medium</u> … - -; or

- -A [[computer program product]] <u>non-transitory computer-readable medium</u> …- -.

Claim Rejections – 35 USC §102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United

States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 43-47, 49-54, and 56 are rejected under 35 U.S.C. 102(e) as being anticipated by Jensen (US 2004/0261086 A1).

Claim 43.

Jensen discloses *a method for adaptive provisioning of an application on a terminal, the method executed on the terminal, comprising:*

receiving the application and associated provisioning instructions, the provisioning instructions specifying provisioning operations to be performed (FIG. 2 and related text)*;*

determining one or more application programming interfaces (APIs) required to perform the provisioning instructions, each of the one or more APIs defining an interface for an API enabler to access an associated content type (FIG. 3 and related text, at least three API enablers: Discovery API 300, Subscription API 302, and Delivery API 304)*;*

retrieving one or more API enablers, each API enabler implementing a respective API and providing functionality required to provision the application (FIG. 4-6, each Discovery/Subscription/Delivery API implements a corresponding API and provides functionality required to provision services/applications)*; and*

executing the provisioning operations specified in the provisioning instructions, using the one or more API enablers, to provision the application in a runtime environment of the terminal (FIG. 2 and related text, executing/provisioning services/applications in target devices 202a-c).

Claim 44.

Jensen discloses the method according to claim 43, wherein provisioning of the application is shared between the runtime environment and the application through the associated provisioning instructions (FIG. 2, services/applications provisioned in the same type of target devices 202a-c are common/shared in the provisioning system 200).

Claim 45.

Jensen discloses the method according to claim 43 wherein a provisioning service determines the one or more APIs required by the provisioning instructions (FIG. 2, each type or target device has specific Provisioning API and Adapter).

Claim 46.

Jensen discloses the method according to claim 45 further comprising: the provisioning service customizing the provisioning of the application using a provisioning API set; the provisioning API set comprising a plurality of APIs specified in the provisioning instructions (FIG. 3 and related text, a Provisioning API set 222 has a plurality of APIs 300, 302, and 304).

Claim 47.

Jensen discloses the method according to claim 46, wherein the provisioning service customizes the provisioning of a plurality of applications using one or more provisioning API sets (FIG. 3, for each type of target devices and for each type of APIs 300, 302, 304, different API sets/instructions are used).

Claim 49.

Jensen discloses the method according to claim 43, wherein the associated provisioning instructions are stored separately from the application (FIG. 2 and related text).

Claim 50.

Jensen discloses the method according to claim 49 wherein receiving the provisioning instructions further comprises accessing a remote repository/database (FIG. 2 and related text, 204 and 220 are remote to 202a-c).

Claim 51.

Jensen discloses the method according to claim 50, wherein accessing includes querying a networked repository/database server (FIG. 2 and related text, Provisioning Application 208 queries a networked database DB 220).

Claim 52.

Jensen discloses the method according to claim 43, wherein the terminal is selected from the group comprising wired devices and wireless devices (FIG. 2, wireless devices 202a-b and wired devices 202c).

Claim 53.

Jensen discloses the method according to claim 43 wherein the API enabler is selected from the group comprising: retrieved locally on the terminal by a provisioning service; bundled with a content descriptor of the application; and retrieved remotely from the terminal by the provisioning service (FIG. 2 and related text, locally for 202c, bundled for 202a, and remotely for 202b).

Claim 54.

Jensen discloses the method according to claim 43, wherein the APIs are defined by one or more entities to customize the provisioning process of the application according to requirements of the respective entity (FIG. 4-6, specific APIs are defined by specific vendors/providers).

Claim 56.

Jensen discloses *the method of claim 43, wherein each of the one or more API enablers is associated with a specific content type used in provisioning the application* (FIG. 3 and related text).

Claim Rejections – 35 USC §103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained through the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 48, 55, and 57-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen in view of Krantz (US Patent No. 2005/0091357 A1).

Claim 48.

Jensen does not disclose *the method according to claim 43, wherein the associated provisioning instructions are selected from the group comprising code, script, and configuration data.*

However, Krantz further discloses *provisioning instructions are selected from the group comprising code, script, and configuration data* (0047, 0063, 0089).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Krantz's teaching into Jensen's teaching. One would have been motivated to do so to provide network provisioning services by using XML rules files, configuration files, and provisioning files as suggested by Krantz (e.g., [0047], [0063], and [0089]).

Claim 55.

Krantz further discloses *the method according to claim 43, wherein a script interpreter executes the provisioning operations, and each of the one or more API enablers exposes the respective API to the script interpreter, each API enabler implementing a service provider interface (SPI) to allow the API enabler to co-operate with the runtime environment to provide required functionality* (0047, 0063, 0089).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Krantz's teaching into Jensen's teaching. One would have been motivated to do so to provide network provisioning services by using XML rules files, configuration files, and provisioning files as suggested by Krantz (e.g., [0047], [0063], and [0089]).

Claim 57.

As set forth in claim 43 above, Jensen discloses *a terminal, including a computer processor and a computer readable storage memory, for adaptive provisioning of applications in a runtime environment, the terminal comprising: a provisioning service for provisioning a received application associated with provisioning instructions, the provisioning instructions specifying provisioning operations defined by one or more application programming interfaces (APIs), each of the one or more APIs defining an interface for an API enabler to access an associated content type, the provisioning service retrieving one or more API enablers, each API enabler implementing a respective API of the one or more APIs and providing functionality required to provision the application.*

Jensen does not disclose *a script interpreter for executing the provisioning operations specified in the provisioning instructions using the one or more API enablers to provision the application in the runtime environment of the terminal.*

However, Krantz further discloses *a script interpreter for executing the provisioning operations specified in the provisioning instructions using the one or more API enablers to provision the application in the runtime environment of the terminal* (0047, 0063, 0089).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Krantz's teaching into Jensen's teaching. One would have been motivated to do so to provide network provisioning services by using XML rules files, configuration files, and provisioning files as suggested by Krantz (e.g., [0047], [0063], and [0089]).

Claims 58-69:

Claims 58-69, which recite(s) the same limitations as those of claims 43-56, wherein all claimed limitations have been addressed and/or set forth above. Therefore, as the reference teaches all of the limitations of the above claim(s), it also teaches all of the limitations of claims 58-69.

Claim 70:

Claim 70 is a computer program product version, which recite(s) the same limitations as those of claim 57, wherein all claimed limitations have been addressed and/or set forth above. Therefore, as the reference teaches all of the limitations of the above claim(s), it also teaches all of the limitations of claim 70.

Conclusion

9. Any inquiry concerning this communication should be directed to examiner Thuy (Twee) Dao, whose telephone/fax numbers are (571) 272 8570 and (571) 273 8570, respectively. The examiner can normally be reached on every Tuesday, Thursday, and Friday from 6:00AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam, can be reached at (571) 272 3695.

Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the TC 2100 Group receptionist whose telephone number is (571) 272 2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Thuy Dao/ (Twee)
Primary Examiner, Art Unit 2192